UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,805	09/26/2000	Scott C. Harris	RTA/SCH	3717

23844 7590 09/23/2011

SCOTT C HARRIS
Law Office of Scott C Harris, Inc
P O BOX 1389
Rancho Santa Fe, CA 92067-1389

EXAMINER	
BORLINGHAUS, JASON M	

ART UNIT	PAPER NUMBER
3693	

NOTIFICATION DATE	DELIVERY MODE
09/23/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

scott@harrises.com
schuspto@gmail.com

Office Action Summary	Application No.	Applicant(s)	
	09/669,805	HARRIS, SCOTT C.	
	Examiner	Art Unit	
	Jason M. Borlinghaus	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *2,5,13-22,25,26 and 29* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *2, 5, 13-22, 25-26 and 29* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Reopened Prosecution

In view of the appeal brief filed on 7/03/2008, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/JAMES KRAMER/
Supervisory Patent Examiner, Art Unit 3693

Acknowledgements

Claims 2, 5, 13-22, 25-26 and 29 are pending.

This office action is being issued in response to the Applicant's filing on 7/03/2008.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 5, 13-22, 25-26 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims are replete with structural and/or language problems.

For example, Claim 2 recites "***allowing*** placing bids …". "[A]llowing" is not an active method step. Therefore, there is no requirement that bids actually are placed. Claim 1 should read "placing bids …"

Claim 5 recites "which keeps the amounts of the bids ***secret*** until a time of day and date that is specified by the indication associated with the bid." In what regards is the amount being kept "secret"? Is it being kept secret from other bidders? From the first computer? From all parties outside of the individual that submitted the bid?

Claims 14 and 15 suffer from similar problems regarding "secret bids" and "known bids." Claims 16 and 17 suffer from similar problems regarding "secret bids" and "non-secret bids." Are "known bids" and "non-secret bids" the same thing?

Claim 13 recites "displaying a current winning amount, which is an amount that exceeds all the other bids on the item, but which may be less than, or the same as, said highest bid." This is a contradiction. If the current winning amount is an amount that exceeds all other bids, then the current winning amount is the highest bid. The current winning bid cannot, as the claim is written, be the same or less than the highest bid.

Claim 13 recites "***displaying a current winning amount***, which is an amount that exceeds all the other bids on the item, but which may be less than, or the same as, said highest bid, depending on a relationship between said highest bid and said all the other bids, and said first computer ***not displaying said highest bid***." This is a contradiction. If the current winning amount is displayed and the current winning amount is the highest bid, then the highest bid must be displayed.

Claims 22 and 25 has similar problems.

Claim 13 recites "***can*** bid" and "***may*** be less" which are deemed to be immaterial claims limitation, as such claim language indicates that the recited steps are optional, in that they may or may not be performed. *see MPEP § 2106 II C*. Claim language such as "if, may, might, can, could", are deemed to be optional claim language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted. The Courts have held that actions which may or may not be performed are indefinite and do not distinguish the claim from the prior art. *In re Collier, 158 USPQ 266 (CCPA 1968).*

Claim 13 recites "enabling a quick bid whereby a user can automatically bid an amount which will exceed the highest bid with a single click." Such a claim limitation is not supported by the original disclosure. In particular, there is no written discussion of "single click" found in the original specification. Further, the drawings, more particularly Figs. 7A and 7B, suggests two clicks, not one. Note that there is one click to either the quick bid or quick win bid icon and a second click to confirm as is shown by the Y/N choice that follows. Accordingly, there is no

support found in the original disclosure for an icon that allows a bid to be placed using a single click. This is further supported by the paragraph at the bottom of page 20 of the specification wherein it is clearly described that the bid is not posted until one clicks "yes". Accordingly, there is no support for the claimed subject matter of the icon allowing the bid to be placed using a single click and thus this subject matter constitutes new matter.

Claims 18 and 29 suffer from similar problems.

Claim 15 recites "***those*** maximum bids." However, this is the first mention of maximum bids.

Claim 17 recites "including ***an extra fee beyond that which would be charged*** for only non-secret bids." Does Applicant mean that an extra fee is charged for non-secret bids? Or that there are fees charged on the non-secret bids but there are "extra fees beyond that" normally charged for non-secret bids that are charged for performance of "the action"?

Applicant is requested to review all pending claims and make all corrections as needed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington (US Patent 6,161,099).

Regarding Claim 2, Harrington discloses a method comprising:

- hosting an Internet auction for an item on a first computer (auctioneer's computer) connected to the Internet. (see col. 4, lines 34-46);

- allowing placing bids for amounts to purchase said item from a second computer (bidders' computers), connected to the Internet. (see col. 4, lines 34-46); and
- storing information on the second computer (bidder's computer) about an amount that will be required to overcome any current bids on the item, but which information allows local determination, at the second computer (bidder's computer), of whether an entered bid is higher than a current bid amount (current highest bid) without contacting said first computer. (see col. 5, lines 20-35).

Harrington also discloses an auction (sealed bid auction/silent and blind auction) in which information indicative of the amount that will be required to overcome any current bids cannot be viewed by a current bidder. (see col. 1, lines 36-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Harrington to automate other auction types, as disclosed by Harrington, thereby obtaining the speed and efficiency of an online auction with other auction types.

Regarding Claim 5, Harrington discloses a method wherein said bids include an indication of time and date (close of auction), which keeps the amounts of the bids secret (sealed) until a time of day and date (close of auction) that is specified by the indication associated with the bid. (see col. 1, lines 36-42).

Harrington also discloses a method comprising providing bids to an agent program (software on bidders' computers). (see col. 5, lines 20-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Harrington to automate other auction types, as disclosed by Harrington, thereby obtaining the speed and efficiency of an online auction with other auction types.

Claim 13-16, 18-22, 25-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington, as applied to Claim 2 above, and further in view of Miller (Miller, Michael. *The Complete Idiot's Guide to Online Auctions.* Que. July, 1999. pp. 17-24 and 190-194).

Regarding Claim 13, Harrington discloses a method of automated auction bidding, comprising:

- on a first computer (auctioneer's computer) connected to the Internet, hosting an auction which allows a plurality of users at remote locations (bidders's

computers), that are remote from a location of said first computer, to bid on an item, (see col. 4, lines 34-46);

- where one of the plurality of users has a highest bid which represents a maximum amount that the one user is willing to pay (current highest bid), and at least one other of the plurality of users can bid an amount that exceeds said highest bid. (see col. 5, lines 20-34); and
- said first computer displaying a current winning amount (best bid), which is an amount that exceeds all the other bids on the item, but which may be less than, or the same as, said highest bid, depending on a relationship between said highest bid and said all the other bids. (see col. 4, lines 34-46).

Harrington does not teach a method wherein there is a highest bid separate and distinct from current winning bid, said first computer not displaying said highest bid; not displaying a minimum bid amount that will be required to exceed said highest bid; and enabling a quick bid whereby a user can automatically bid an amount which will exceed the highest bid with a single click .

Miller discloses a method wherein:

- there is a highest bid (maximum bid entered into automated bidding software) separate and distinct from current winning bid (current bid price). (see pp. 18-23);
- not displaying a minimum bid amount (bid increment) that will be required to exceed said highest bid (maximum bid entered into automated bidding software). (see pp. 18-23); and
- enabling a quick bid whereby a user can automatically bid an amount which will exceed the highest bid (current bid price) with a single click. (see pp. 190-194).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Harrington by incorporating bidding practices, as disclosed by Miller, which are conventional and standard in the practice of online auctions.

Regarding Claims 14-16, Harrington discloses a method wherein there is a plurality of bids. (see abstract).

Harrington does not teach a method wherein there are a plurality of bids, some of which are known and others of which are secret, and wherein said quick bid only overcomes those bids which are known; said plurality of bids are associated with times when those maximum bids

can be made, and only those bids whose times have been reached are known; and enabling an action which allows determining both secret bids and non-secret bids.

Miller discloses a method wherein:

- there are a plurality of bids, some of which are known (current bid price) and others of which are secret (maximum bid entered into automated bidding software), and wherein said quick bid only overcomes those bids which are known (current bid price). (see pp. 18-23);
- said plurality of bids are associated with times when those maximum bids (maximum bids entered into automated bidding software are activated when outbid) can be made, and only those bids whose times have been reached are known (become current bid). (see pp. 18-23);
- enabling an action which allows determining both secret bids (maximum bids entered into automated bidding software) and non-secret bids (current bids). (see pp. 18-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Harrington and Miller by incorporating bidding practices, as disclosed by Miller, which are conventional and standard in the practice of online auctions.

Regarding Claim 18, Harrington discloses a system, comprising:

- a server (auctioneer's computer) running a program that displays information about an item to be auctioned, and accepts bids on said item, and keeps track of a maximum bid (current best bid); and
- a client (bidders' computer), enabling and sending a bid to said server (auctioneer's computer). (see col. 4, lines 34-46).

Harrington does not teach a system wherein the bid is sent with a single click which includes an amount of a bid.

Miller discloses a system wherein the bid is sent with a single click which includes an amount of a bid. (see pp. 190-194).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Harrington and Miller by incorporating bidding practices, as disclosed by Miller, which are conventional and standard in the practice of online auctions.

Regarding Claims 19-20, Harrington discloses a system wherein:

- said server automatically updates at least one screen being seen on at least one client to automatically show new bid amounts. (see col. 11, lines 20-41); and
- said client allows sending a plurality of bids, to be executed at a plurality of times. (see col. 4, lines 34-46).

Regarding Claims 21-22, Harrington does not teach a method wherein an amount of said quick bid is displayed responsive to a specified action by the user; or said auction is one in which the server stores maximum bid amounts by users, but only displays a current bid amount without displaying said maximum bid amount, and wherein said values stored at said second computer determines whether an entered bid is higher than said maximum bid amounts.

Harrington discloses a method wherein said values stored at said second computer determines whether an entered bid is higher than said maximum bid amounts. (see col. 5, lines 20-34).

Miller discloses a method wherein:

- an amount of said quick bid is displayed responsive to a specified action (e.g. entering data) by the user. (see pp. 191-192); and
- said auction is one in which the server stores maximum bid amounts (maximum bids entered into automated bidding software) by users, but only displays a current bid amount without displaying said maximum bid amount (maximum bids entered into automated bidding software). (see pp. 18-23 and 190-194).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Harrington and Miller by incorporating bidding practices, as disclosed by Miller, which are conventional and standard in the practice of online auctions.

Regarding Claims 25-26 and 29, such claims recite substantially similar limitations as claimed in previously rejected claims and, therefore, would have been obvious based upon previously rejected claims or are otherwise disclosed by the prior art applied in previously rejected claims.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington and Miller, as applied to Claim 16 above, and further in view of ***Official Notice.***

Regarding Claim 17, Harrington does not teach a method wherein said action includes an extra fee beyond that which would be charged for only non-secret bids.

Examiner takes Official Notice that it is old and well known in the art of auctions to charge fees for provision of extra features and performance of extra functions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Harrington and Miller to incorporate extra fees, as are old and well known in the art, therefore generating revenue through fees generated by the performance of functions.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571)272-6924. The examiner can normally be reached on Monday - Friday; 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on (571)272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason M Borlinghaus/
Primary Examiner, Art Unit 3693
September 14, 2011